

Application No. To be assigned

Preliminary amendment dated October 23, 2003

### REMARKS

The Applicants have canceled claims 1-96 and hereby added new claims 97-100 in the present application which is a continuation application of U.S. Patent Application Serial No. 10/622,905 filed July 18, 2003.

The added X-ray powder diffraction patterns are characterization of crystalline nateglinide produced by example 17. Example 17 in its entirety has been disclosed in the specification of the parent of this case. The X-ray powder pattern is an inherent characteristic of the crystalline compound since each compound produces its own characteristic powder pattern. *See Polymorphism in Pharmaceutical Solids*, Drugs and the Pharmaceutical Sciences, Vol. 95, pg 236.

Regarding the new claims, the Applicants note that the peaks at 4.7, 7.4, 13.8 and 17.0 $\pm$ 0.2 theta are expressly disclosed in Table 1 of the specification. The additional peak at 3.8  $\pm$  0.2 is disclosed in Figure 17. The Applicants did not include this peak in Table 1 since it is not characteristic of Form U. Additionally, one of skill in the art would readily understand after obtaining Form U from example 17 that Form U does not have a characteristic peak at 3.8  $\pm$  0.2 as disclosed in Figure 17.

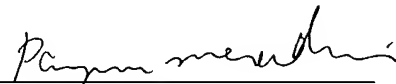
Accordingly, no new matter has been introduced by the claim amendment. *See* MPEP 2163.07(a). *See also In re Nathan*, 328 F.2d 1005 (C.C.P.A. 1964).

The Applicants believe that the pending claim is free of prior art and patentable and allowance of this claim is respectfully requested. The Examiner can reach undersigned at (212) 908-6162 when this application is taken up for further action.

Respectfully submitted,

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